

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Mehtali, Majid et. al.

Application No.: 09/810,490

Filing Date: March 19, 2001

Title: Viral vectors and line for gene therapy

Group Art Unit: 1636

Examiner: GUZO, DAVID

Confirmation No.: 9942

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per  
Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the  
☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered.  
Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted \_\_\_\_\_  
\_\_\_\_\_  
on \_\_\_\_\_,  
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least \_\_\_\_\_,  
which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R.  
§ 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also  
enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	23	MINUS 23 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	2	MINUS 3 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
<b>TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT</b>					<b>\$ 0.00</b>

- ☐ A check in the amount of \_\_\_\_\_ is enclosed for the fee due.
- ☐ Charge \_\_\_\_\_ to Deposit Account No. 02-4800.

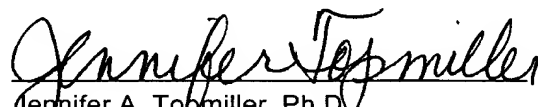
The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

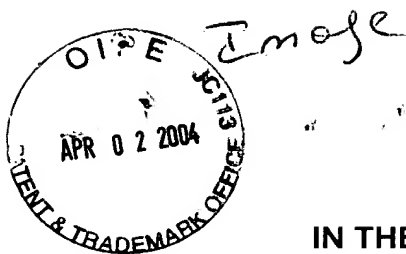
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: April 2, 2004

By   
Jennifer A. Toomiller, Ph.D.  
Registration No. 50,435



1636

Patent  
Attorney's Docket No. 032751-061

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
MEHTALI, Majid et. al.	)	Group Art Unit: 1636
Application No.: 09/810,490	)	Examiner: GUZO, DAVID
Filed: March 19, 2001	)	Confirmation No.: 9942
For: Viral vectors and line for gene therapy	)	

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In complete response to the Office Action mailed March 24, 2004, Applicants hereby elect, albeit with traverse, Group I, Claims 2-35 and 39-59, drawn to viral vector and particles, complementation cell lines, and a method of preparing infectious viral particles.

Initially, Applicants note that the statement of claims pending in the present application appears to be in error. Applicants respectfully submit that only Claims 39-61 are currently pending. Claims 2-38 were canceled in the transmittal letter submitted on March 19, 2001 (see item #8 on p. 2). Claim 1 was canceled in the Preliminary Amendment also filed on March 19, 2001. Thus, only Claims 39-61 should be considered pending. Applicants further request that the amendment to the specification regarding the related application data requested in the transmittal letter submitted on March 19, 2001 (see item #9 on p. 2) be acknowledged.

According to M.P.E.P. § 803, a restriction requirement between patentably distinct inventions is proper only when there is a serious burden on the examiner to

examine all of the claims in a single application; this is true even when appropriate reasons exist for restriction requirement. Applicants respectfully submit that the searches required to completely examine both groups of claims would substantially, if not completely, overlap. In particular, Applicants draw attention to the fact that the only pending claims of Group II, Claims 60 and 61, are directly or indirectly dependent upon Claim 39 of Group I. Thus, to examine these two additional claims, the Examiner must conduct a similar search required to examine Claim 39 of Group I.

Applicants respectfully submit that it would not be unduly burdensome for the Examiner to search and examine all claims of the present application on the merits at the present time. Applicants therefore request rejoinder of Groups I and II, Claims 39-61, and examination of all pending claims on the merits at the present time. Applicants further submit that the present claims already comply with the provisions for rejoinder as discussed on page 3 of the current Office Action because the claims of Group II already depend directly or indirectly from Claim 39 of Group I.


If there are any questions concerning this reply or the application in general,  
the Examiner is respectfully requested to telephone Applicants undersigned  
representative so that prosecution may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: April 2, 2004

By:

  
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Registration No. 50,435

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